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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/803,463 03/09/01 CAPOCCIA

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IM22/0604

EXAMINER

CHIN, R

ART UNIT

PAPER NUMBER

1744

DATE MAILED:

06/04/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

803,463

Applicant(s)

CAPOCCIA

Examiner

R. CHIN

Group Art Unit

1744

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-24 is/are pending in the application.
- Of the above claim(s) 7-19 is/are withdrawn from consideration.
- ☒ Claim(s) 1-6 and 20 is/are allowed.
- ☒ Claim(s) 21-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

1. Applicant's election of the patterned sponge made in the parent Application Serial Number 09/344,479 has been maintained in the instant application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claim 21 is rejected under 35 U.S.C. 102(e) as being anticipated by McLaughlin '472.

The patent to McLaughlin '472 discloses all of the recited subject of claim 21 as shown in Fig.2.

As for the claim reciting that the device is a paint roller for two-color faux finishes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA

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1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly, each of McLaughlin's sponges are "capable" of being dipped into different colored paint.

4. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lustofin '472.

The patent to Lustofin '472 discloses all of the recited subject of claims 21 and 22 as shown in Fig.2 (see col.3, lines 8-9).

As for claim 21 reciting that the device is a paint roller for two-color faux finishes, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Clearly, each of McLaughlin's sponges are "capable" of being dipped into different colored paint.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cademartori '479.

The patent to Cademartori '479 discloses with respect to claim 21 a paint roller head which comprises a pair of elongated annular sponges, which may be any two of the individual applicator pads 21 that are "spaced-apart" (see col.2, lines 51-56) both of which surmount an interior annular core 8. First, it should be noted that the term "spaced-apart" in claim 21 does not necessarily require provision of an open gap or space between the two sponges. It is sufficient that any two sponges are by "spaced-apart" by a distance which Cademartori teaches by any two individual pads 21 (see Fig.1). Second, it would appear that axle portion or core 8 extends through the roller as opposed to being of a U-shape and only affixed at the end plates 12. However, assuming arguendo that axle or annular core 8 does not extend through the roller, it is the position of the Examiner that such a roller-core arrangement is old and well known in the roller art and merely depends on the desired structural arrangement. Either arrangement are deemed to be functional equivalents. Each of Cademartori's sponges are clearly "capable" of being dipped into different colored pain for creating two-color faux finishes. There is no requirement that the different colored paint must be in separate trays.

As for claim 22, the sponges can be polyurethane or sponge rubber (see col.2, lines 27-30).

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As for claim 23, the choice of open cell material is within the level of ordinary skill depending on the desired absorption capability of the paint roller.

As for claim 24, such language is deemed broad and Cademartori's sponges also bear a "pattern," namely the longitudinal slits 16 on the outer surface of the sponges shown in Fig. 1 define such "pattern."

8. Claims 1-6 and 20 are allowed.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Coley, Christensen, and Tramont are pertinent to various other roller designs.

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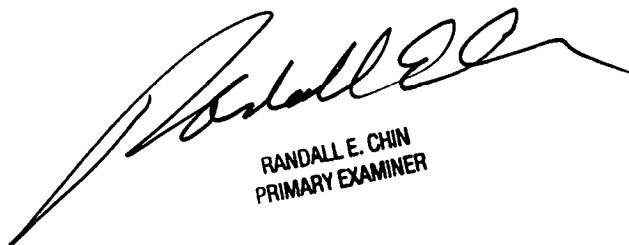
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Chin whose telephone number is (703) 308-1613.

Any inquiry of a general nature concerning the status of this application should be directed to the receptionist of Group 1700 whose telephone number is (703) 308-0661.

Any responses made by facsimile should be addressed to Randall Chin at (703) 305-3599 or (703) 305-7719.



R. Chin
May 30, 2001



RANDALL E. CHIN
PRIMARY EXAMINER